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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,707	03/10/2004	Fiona Patricia Carney	CL/V-32903A	4227

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CIBA VISION CORPORATION
PATENT DEPARTMENT
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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/797,707	Applicant(s) CARNEY ET AL.	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 09/14/2006, amendment(s) to the specification, amended claim(s) 14, 15, 17, 19, and 20, canceled claim(s) 1-13 is/are acknowledged. The current rejections of the claim(s) 14-20 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Terminal Disclaimer

2. The terminal disclaimer filed on 09/14/2006 disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of Application No. 10/767,678 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Drawings

3. The drawings were received on 09/14/2006. These drawings are *-not acceptable--* because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the positive citation of "a concave surface 11" and "a convex surface 12".

4. The examiner notes Applicant may desire to cite "a front surface 11" and "a back surface 12" which appears to be supported in the disclosure.

Specification

5. The amendment filed 09/14/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the positive recitation of "a concave surface 11" and "a convex surface 12".

Applicant is required to cancel the new matter in the reply to this Office Action.

6. The examiner notes Applicant may desire to recite "a front surface 11" and "a back surface 12" which appears to be supported in the disclosure.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Everhart et al (US 6,060,256). For claim 14, Everhart et al discloses a biosensor, comprising: a kit for collecting an analyte of interest in a body fluid (column 2 lines 10-12), comprising: a contact lens (column 3 lines 25-28) capable of binding the analyte of interest in a tear fluid, wherein said contact lens has molecular imprints (column 2 lines 12-15, the patterned monolayers for example in column 7 lines 21-65, and the

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lithography and etching for in example in column 10 line 60 – column 12 line 68) for the analyte of interest.

9. For claims 15-16, Everhart et al discloses a biosensor wherein the contact lens (column 3 lines 25-28) further comprises surface charges that are introduced by applying an LbL coating composed of at least one layer of a polyionic material onto the contact lens (column 7 lines 21-34).

10. For claims 17 and 18, Everhart et al discloses a biosensor wherein the contact lens further comprises a coating comprising a receptor which binds specifically the analyte of interest wherein said receptor is selected from the group consisting of antibodies, lectins, hormone receptors, drug receptors, enzymes, aptamers, nucleic acids, nucleic acid analogs, and fragments thereof (column 6 lines 11-30).

11. Claims 19-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Everhart et al.

12. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

13. For claim 19, Everhart et al discloses a biosensor wherein the contact lens has molecular imprints for the analyte of interest (column 7 lines 21-34).

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14. For claim 20, Everhart et al discloses a biosensor wherein the contact lens a polymerizable composition comprises a receptor that binds specifically the analyte of interest (the plastic and receptor positively recited in column 4 lines 28-38).

Response to Arguments

15. Applicant's arguments filed 09/14/2006 have been fully considered but they are not persuasive. Applicant argues Everhart et al does not disclose nor teach anything about molecular imprints for an analyte of interest distributed within a contact lens. The Examiner disagrees and maintains as broadly as structurally claimed Everhart et al discloses a contact lens structure comprising molecular imprints.

16. In response to applicant's argument that Everhart et al does not disclose nor teach anything about molecular imprints for an analyte of interest distributed within a contact lens, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The examiner notes as broadly as structurally claimed Everhart et al discloses a contact lens structure capable of binding the analyte of interest in a tear fluid (column 2 line 10 – column 3 line 29).

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

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